

**IN THE OFFICE ACTION**

In the action, Claims 1-25 are pending. Claims 24 and 25 are withdrawn from consideration. Claims 1-25 are rejected. The disclosure is objected to because of informalities. The Claims 1-23 are rejected under 35 U.S.C. 112, Second Paragraph, as being indefinite. Claims 1-7, 9-19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Zeng* (USPN 5,525,471), in view of *Burmer* (Burmer et al.,USPN 5,935,788). Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Zeng*, in view of *Burmer*, and in further view of *Kozian* (Kozian et al., USPN 6,342,376).

**REJECTIONS**

The Specification is amended. Informal citations and browser-executable code have been removed. Claims 1-25 are cancelled. Therefore, the objections raised by the Examiner have been addressed.

Regarding the rejection under 35 U.S.C. 112, second paragraph, Claims 1-25 are cancelled. New claims are presented, which point out and claim subject matter that the inventor regards as inventive.

Regarding the rejections under 35 U.S.C. 103(a), among various aspects of the Claims, *Zeng* and *Burmer* fail to show the combination of RNA strands from one sample with cDNA strands from another. The Examiner alleges that "*Burmer* teaches a method of subtractive hybridization, wherein RNA can be used as the second nucleic acid in a subtractive hybridization ... (col. 4 )(claims 6 and 18.)" However, in the subsequent sentence in the specification of *Burmer* (col. 4, lines 47-53), *Burmer* states for "any of the methods described herein, it will be understood that RNA viruses, novel mRNAs expressed in cancers and other RNAs of interest, such as RNA used as a representation of a genome of interest, can be detected by first obtaining the corresponding cDNA." The methods of *Burmer* are directed to cDNA/cDNA hybridization.

Further, both *Zeng* and *Burmer* isolate hybridized compliments. The methods of the present invention degrade hybridized compliments. As a result, the methods produce differing nucleic acid products.

### **NEW CLAIMS**

New claims 25 through 47 are added. Among others aspects, the independent claims cite the mixing of a cDNA sample with an RNA sample and the degradation of hybridized compliments. The dependent claims also cite aspects that differ from the cited references. Further, if a dependent claim depends from an allowable independent claim, the dependent claim is allowable.

### **CONCLUSION**

The Applicants have amended the Specification, cancelled Claims 1 through 25, and added Claims 26 through 47. Applicants have presented arguments traversing *Zeng*, and *Burmer*. As such, the Applicants submit that the claims are allowable and respectfully request that a notice of allowance be issued for all claims hereby submitted.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact Dr. Robert Chin at (512) 569-4539.

Respectfully submitted,



---

John R. Schell  
Reg. No. 50,776  
AGENT FOR APPLICANTS

2110 A Eva St.  
Austin, Texas 78704  
(512) 804-0385  
March 4, 2003